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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,762	11/21/2003	Thomas M. Laney	87340AEK	3100

7590

07/25/2005

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/719,762

Applicant(s)

LANEY ET AL.

Examiner

Victor S. Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/21/03, 2/25/05</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Specification

1. Please update the cross-reference in the next reply.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6846606.

Although the conflicting claims are not identical, they are not patentably distinct from each other because US '606 discloses all the structural and composition elements of instant invention, and disclosed at least 90% reflectivity in the wavelength range of about 300 to about 700 nm also reads on instantly claimed reflectivity.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 06-067174 (computer translation) in view of JP 2001-049004 (computer translation).

JP '174 is directed to a reflector mounted at a light source of a surface light source device suitable for a liquid crystal display. The reflector comprises a white plastic film containing white pigments (paragraph 0005), and a porous white polyester film is especially desirable from the point of a reflection factor (paragraph 0008).

Titanium oxide, and barium sulfate, etc., can be used for it as white pigments (paragraph 0008). In Table 1, JP '174 shows that the reflectance is measured with a wavelength of 550 nm (a visible light wavelength).

For claims 1, 6 and 18, although JP '174 teaches that a porous white polyester film is especially desirable, JP '174 lacks a specific teaching of a lactic acid based white polyester film. However, it is noted that JP '004 is directed to a white polyester system film characterized by containing inorganic particle and/or organic particle inside said film (paragraph 0009). Suitable polyesters include polylactic acid, etc. (paragraph 0010). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to select a white polylactic film of the reflector of JP '174. It should be noted that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP §

2144.07. Regarding the amount of the reflectivity, since the combined teachings of the prior discloses all the structural/composition elements as claimed, it is the Examiner's position that, in the absence of unexpected results, a suitable reflectivity is an obvious optimization to one of ordinary skill in the art of reflectivity. It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

For claim 2, the Examiner notes that titanium dioxide is inherently a UV absorber.

For claims 3 and 4, JP '004 teaches that although optical isomers, such as L-object, DL-object, and D-object, exist, those any are sufficient as the object which has asymmetrical carbon in a polymer, and the mixture of these isomers is sufficient as it (paragraph 0010).

For claims 5 and 7-10, JP '174 and JP '004 are silent about suitable range of the amount and particle size of titanium dioxides. However, the Examiner notes that since the combined teachings of the prior are directed to the same subject matter (a polylactic reflective film), and made by the same general process (extrusion) as instant invention, it is the Examiner's position that, in the absence of unexpected results, suitable range of the amount and particle size of titanium dioxides are also obvious optimizations to one of ordinary skill in the art of reflectivity.

For claims 11, 15 and 16, in the absence of distinct structural/composition limitations for the second layer, the Examiner notes that the teachings of JP '174 and JP '004, as set forth above, also read on the instantly claimed invention. Further, optical isomers are suitable as set forth above.

For claims 12, 13 and 17, JP '004 expressly teaches that incompatible thermoplastic particles such as polypropylene, etc., can be used to form cavities (paragraph 0015). Further, co-extruded multilayer film can be used to meet required characteristics to the film by placing additives in desired layers (paragraphs 0025-0026). Further, it should be noted that claim to rearranged elements of the prior art has been held unpatentable when the rearrangement does not modify the operation of the article. See MPEP § 2144.04.VI.C.

For claim 19, JP '174 teaches a reflector for a liquid crystal display as set forth above.

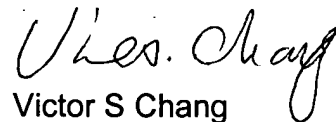
Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor S Chang
Examiner
Art Unit 1771

7/20/2005